

REMARKS

This Amendment is submitted simultaneously with filing of the application.

It is noted in the parent case that the claims have been rejected under 35 U.S.C. 102 over the patents to Tanaka or Enomoto and also under 35 U.S.C. 103 over the same references.

After carefully considering the Examiner's grounds for the rejection of the claims, applicants have canceled all claims and submitted a new set of claims.

It is respectfully submitted that the claims currently on file clearly and patentably distinguish the present invention from the references applied by the Examiner in the parent case against the original claims.

Claim 17 defines that the particles of the particulate material are treated with an electrically conductive substance. When the particles

are composed of an electrically conductive material the electrically conductive substance which treats the particles enhances their electrical conductivity and therefore improves the sensitivity of the device. The particles of the particulate material can be non conductive, in which case the electrically conductive substance imparts to them the electrically conductive property. This is very advantageous since it is now possible to use non-conductive particles for the device of the present invention which was not possible before.

The new features of the present invention as defined in claim 17 as well as in the dependent claims are not disclosed in the references and can not be derived from them as a matter of obviousness. The Examiner indicated that such features can be just considered as obvious. However, applicants have to respectfully disagree. First of all, none of the references teaches such features of the present invention. In order to arrive at the present invention as defined in the above mentioned claims from the teaching of the references, the references have to be fundamentally modified by providing such a body of particulate material in which the particulate materials (electrically conductive or non conductive) are covered with an electrically conductive substance. However, it is

known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has also been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in re Randol and Redford (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggest; it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

Definitely, the references do not contain any hint or suggestions for such modification.

The above mentioned new features of the present invention provide for the highly advantageous results as were explained herein above which advantageous results are important, unobvious, and make the claims which define these features clearly patentable.

It is well known that in order to support a valid rejection the art must also suggest that it would accomplish applicant's results. This

was stated by the Patent Office Board of Appeals, in the case Ex parte Tanaka, Marushima and Takahashi (174 USPQ 38), as follows:

Claims are not rejected on the ground that it would be obvious to one of ordinary skill in the art to rewire prior art devices in order to accomplish applicants' result, since there is no suggestion in prior art that such a result could be accomplished by so modifying prior art devices.

It is therefore believed that claims 17-20 should be considered as patentably distinguishing over the art and should be allowed.

The Examiner's attention is respectfully directed to the features of claim 23. Claim 23 defines the electrodes of the device and their height and width corresponding to the height and width of the body of the particulate material. The thusly selected dimensions of the electrodes provide their optimal arrangement in the device and also optical electrical behavior of the device. These features are also not disclosed in the references and can not be derived from them as a matter of obviousness.

It is believed that the above cited decisions are completely applicable with respect to claim 23 as well.

The above listed additional claims should also be considered as patentably distinguishing over the art and should be allowed.

Consideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-243-3818).

Respectfully submitted,

Ilya Zborovsky
Agent for Applicant
Reg. No. 28563